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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/963,311	09/26/2001	Noriaki Nada	MAT-8187US	1311

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EXAMINER

REFAI, RAMSEY

ART UNIT	PAPER NUMBER
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2152

DATE MAILED: 06/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/963,311

Applicant(s)

NADA, NORIAKI

Examiner

Ramsey Refai

Art Unit

2152

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. Responsive to Amendment received March 14, 2005.

Claims 1, 2, 8, 14, and 16 have been amended.

Claims 1-16 remain pending examination.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-2, 7-8, and 13-16 are rejected under 35 U.S.C. 102(e) as being anticipated by

Borella et al (U.S. Patent No. 6,731,642).

4. As per claims 1, 8, 14, 15, and 16, Borella et al teach an Internet telephone system, apparatus, and method for making a telephone call through Internet, comprising:

a) a first telephone set (**Figure 1, 24**);

b) a first modem coupled to the first telephone set for communicating with the Internet (**Figure 1, 18**);

c) a second telephone set (**Figure 1, 26**);

d) a second modem coupled to the second telephone set for communicating with the Internet (**Figure 1, 20**); and

e) a server connected to the Internet for storing a telephone number and an IP address corresponding to the telephone number (**Figure 1, 34 and column 6, line 61 – column 7, line 22**), wherein said first modem, after being assigned with an IP address, transmits a telephone number of the first telephone set and the assigned IP address to the server to register the telephone number (**column 7, lines 24-48**) and the assigned IP address in the server, and acquires an IP address corresponding to a telephone number of the second telephone set from the server, when the telephone number of the second telephone set is entered in the first telephone set, and transmits a connection request to said second modem (**column 8, lines 16-45, column 8, line 15-column 9, line 55**).

5. As per claim 2, Borella et al teach said first modem and said first telephone set include a **telephone function (Figure 1, 24 and 18, abstract)**.

6. As per claims 7 and 13, Borella et al teach a host server of the server, wherein if an IP address of the server is a local IP address usable within a specific network, a unique IP address of the server and the telephone number registered in the server are registered in the host server by relating to each other (**column 7, lines 23-55; the server relates the caller station number with the caller address, the router and the gatekeeper**).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3-5, and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borella et al (U.S. Patent No. 6,731,642) as applied to claim 1 above, and further in view of Thornton et al (U.S. Patent No. 6,363,065).

9. As per claims 3 and 9, Borella et al fail to teach said first modem communicates with said second modem through a public switching network if not replied from the server.

10. However, Thornton et al teach dynamically switching a call between callers a data network (IP network) using a first and second modem (**Figure 1**) to the PSTN in the event of a failure of an IP connection (**column 4, lines 12-22 and 44-53**). It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention to combine the teachings of Borella et al and Thornton et al because Thornton et al's use of switching a call from an IP network to a PSTN would enhance Borella's system by allowing a caller on a internet telephony system to still connect to a callee on the IP network using the PSTN.

11. As per claims 4 and 10, Borella et al fail to teach said first modem communicates with said second modem through a public switching network if the IP address corresponding to the telephone number of the second telephone set is not received from the server.

12. However, Thornton et al teach dynamically switching a call between callers a data network (IP network) using a first and second modem (**Figure 1**) to the PSTN in the event of a failure of an IP connection (**column 4, lines 12-22 and 44-53**). It would have been obvious to

one of the ordinary skill in the art at the time of the applicant's invention to combine the teachings of Borella et al and Thornton et al because Thornton et al's use of switching a call from an IP network to a PSTN would enhance Borella's system by allowing a caller on a internet telephony system to still connect to a callee on the IP network using the PSTN when the caller fails to obtain an IP address from the database in the server.

13. As per claims 5 and 11, Borella et al fail to teach said first modem communicates with said second modem through a public switching network if not replied from the second modem when making a connection operation to the second modem by obtaining the IP address corresponding to the telephone number of the second telephone set from the server.

14. However, Thornton et al teach dynamically switching a call between callers a data network (IP network) using a first and second modem (**Figure 1**) to the PSTN in the event of a failure of an IP connection (**column 4, lines 12-22 and 44-53**). It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention to combine the teachings of Borella et al and Thornton et al because Thornton et al's use of switching a call from an IP network to a PSTN would enhance Borella's system by allowing a caller on a internet telephony system to still connect to a callee on the IP network using the PSTN when the caller fails to connect to a modem connected to callee.

15. Claims 6 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borella et al (U.S. Patent No. 6,731,642) as applied to claim 1 above, and further in view of Moon (U.S. Patent No. 5,864,758).

16. As per claims 6 and 12, Borella et al fails to teach said first modem stores registration information if not replied from the server after transmitting registration information to the server, and transmits the registration information again to the server to register the registration information in the server when the telephone number is entered in the first telephone set.

17. However, Moon teaches information is stored by the modem and retransmitted from one call-attempt to the next during a communications session (**column 8, lines 29 – 35**). It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention to combine the teachings of Borella et al and Moon because Moon's use of a modem storing information and resending information during a call attempt would enhance Borella's system by allowing a modem to store registration information when an attempt to register at a server fails and resending the registration information during another call attempt which would save time by needing to acquire the registration information once more.

Response to Arguments

18. Applicant's arguments have been fully considered but they are not persuasive.

- In the remarks, the applicant is arguing in substance that:
 - a. Borella et al fail to teach acquiring an IP address corresponding to a telephone number of the second telephone set from the server;
 - b. Borella et al fail to teach transmitting a connection request to said second modem.
- In reply to:

- a. Examiner respectfully disagrees because Borella et al teach a database used by server 34 that is relational and given a station number, is able to determine the address of that station as well as addresses of the router and gatekeeper associated with that station. (See column 6, line 61-column 7, line 8, column 8, lines 16-64).
- b. Examiner respectfully disagrees because Borella et al teach a ring message that is sent to a callee station, which provides an indication to the callee station that a telephone call has been directed to it. (See column 9, lines 19-35, column 8, line 16-column 51).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

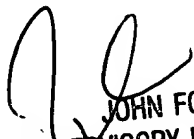
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramsey Refai whose telephone number is (571) 272-3975. The examiner can normally be reached on M-F 8:30 - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ramsey Refai
Examiner
Art Unit 2152

RR
June 13, 2005


JOHN FOLLANSBEE
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